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Attorney Docket No. P67074US0

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: A. MUSCATE-MAGNUSSEN

Serial No.: 09/933,811

Group Art Unit: 1743

Filed: August 22, 2001

Examiner: J. LUDLOW

For: USE OF SUPPORT MATERIALS IN CAPILLARY ELECTROCHROMATOGRAPHY

TRANSMITTAL LETTER

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith are (1) Request Under MPEP 706.07(d) to Withdraw Premature Final Office Action, (2) Resubmitting of PTO Form-1449, Search Report, and References, and (3) a response (Response and Resubmitting of Priority Document Translations.

The response is filed without prejudice to the Request Under MPEP 706.07(d) to Withdraw Premature Final Office Action.

No fee is considered necessary to file any of the papers transmitted herewith. Should any fee be necessary, please charge Deposit Account No. 06-1358.

Respectfully submitted,

JACOBSON HOLMAN PLLC

By

William E. Player

Reg. No.: 31,409

400 Seventh Street, N.W.
Suite 600
Washington, D.C. 20004
Tel. (202) 638-6666
Fax (202) 393-5350
Date: March 7, 2005
WEP/bad

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**REQUEST UNDER MPEP 706.07(d) TO WITHDRAW PREMATURE
FINAL OFFICE ACTION**

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P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Request is made, hereby, for reconsideration and withdrawal of the "Final" Office Action, mailed February 10, 2005, and for a new, non-final action in place of the Final Action, which new action restarts the time period for response. As explained, below, withdrawing finality of the Office Action is required, in accordance with MPEP 706.07(a) and 706.07(d), because the Final Action contains a *new ground of rejection* that was *not necessitated by amendment of the claims*, which renders the finality *premature*.

When finality of an Office Action is "premature," the "finality of the Office Action must be withdrawn." MPEP 706.07(d). A final Office Action is "premature," for purposes of MPEP 706.07(d),

where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

MPEP 706.07(a).

The Final Action contains acknowledged *new grounds of rejection*, i.e., the rejection of claims 32, 41, 42, and 43 under 35 USC 102(b) and claims 33-40, 42, and 44-52 under 35 USC 103(a) based on the teachings of US 4,544,485 (Pinkerton). The Final Action *incorrectly* alleges that the new grounds of rejection were "necessitated" by "Applicant's amendment."

Rejected claims 37-52 contain the identical subject matter of original claims 1-16, respectively, examined in the previous Office Action (mailed March 3, 2004). First, present dependent claims 38-52 are identical to original dependent claims 2-16, respectively (changed only to be dependent directly or indirectly on claim 37). Secondly, present independent claim 37 is identical to original claim 1 except for two minor formality changes (made only to overcome a rejection under §112, ¶2), i.e.:

- 1) changing – "A capillary electrochromatography (CEC) device comprising" – in claim 1
to – "A device for capillary electrochromatography (CEC) comprising" – in claim 37,
wherein no substantive change is readily apparent, with essentially the same words being
used, merely ordered differently.
- 2) changing – "support material (60) which has a porous design" – in claim 1
to – "porous support material (60)" – in claim 37,
wherein no substantive change is readily apparent, with essentially the same words being
used, merely ordered differently.

Again, it is readily apparent that no substantive change occurs – merely a rearrangement of the words used.

Since the subject matter in original claims 1-16 was not changed by the amendment filed between the previous Office Action and the present, Final Office Action, the new grounds of

rejection against claims 37-52 were not – and could not have been – "necessitated" by "applicant's amendment," allegations to the contrary in the Final Action, notwithstanding.

Furthermore, the record shows that the new grounds of rejection were *necessitated* by something *other than* applicant's amendment. At page 2 of the previous Office Action it is stated (*emphasis added*):

The prior art made of record *and not relied upon* is considered pertinent to applicant's disclosure. . . . *Pinkerton* teaches the instantly disclosed packings but *does not suggest electrochromatography*.

In other words, claim 1, *i.a.*, was not rejected over *Pinkerton* (in the previous Office Action) because it was found that *Pinkerton* failed to meet the "electrochromatography" limitation in the claim.

On the other hand, the subject matter of original claim 1 – as present claim 37 – *was* rejected over *Pinkerton* in the Final Office Action, which found (page 3) (*emphasis added*)

that the intended use "for capillary *electrochromatography* recited in the preamble has not been given weight because there are no corresponding structural limitations defining over a chromatography system . . . [and] *Pinkerton* fails to teach the *specific* chromatographic set-ups claimed.

The aforesaid findings in the Final Office Action are inconsistent with the aforesaid findings in the previous Office Action. In the previous Office Action, the "electrochromatography" limitation in the preamble of claim 1 was *given weight* and, so, not rejected over *Pinkerton* because the reference "does not suggest" the "electrochromatography" limitation; whereas, in the Final Office Action the same subject matter "in claim 37" was, contrarily, rejected over *Pinkerton*, because the preamble recitation "electrochromatography . . . has *not* been given weight" (*emphasis added*). In other words,

the new grounds of rejection were *necessitated* by the examiner's change of opinion concerning the patentable weight to be given the "electrochromatography" limitation – *not* by applicant's amendment.

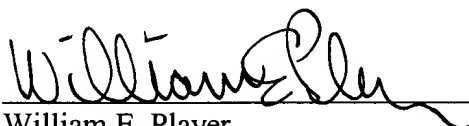
Being that the Final Action is one "where the examiner introduces a new ground of rejection that is . . . [not] necessitated by applicant's amendment of the claims," making the Action "Final" was "premature." MPEP 706.07(a). Being "premature," the "Finality of the Office Action must be withdrawn." MPEP 706.07(d).

For the foregoing reasons, the "Final" Action was premature and, so, the Finality must be withdrawn. MPEP 706.07(a) & 706.07(d). Accordingly, a new, non-Final Office Action issued by the PTO is in order – in place of the Final Action – which new Action resets the time period for response as of its mailing date.

Favorable action is requested.

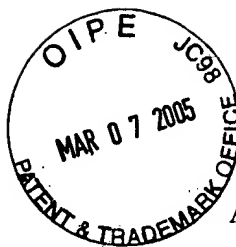
Respectfully submitted,

JACOBSON HOLMAN PLLC

By 
William E. Player
Reg. No.: 31,409

400 Seventh Street, N.W.
Washington, D.C. 20004
Tel. (202) 638-6666
Fax (202) 393-5350
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Filed: August 22, 2001

Examiner: J. LUDLOW

For: USE OF SUPPORT MATERIALS IN CAPILLARY ELECTROCHROMATOGRAPHY

**RESPONSE AND RESUBMITTING OF
PRIORITY DOCUMENT TRANSLATIONS**

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

The instant paper, which responds to the final Office Action (mailed Feb. 10, 2005), is filed without prejudice to applicant's paper concurrently filed, herewith, requesting withdrawal of the final Office Action and issuing of a new, non-final Action that restarts the time period for response.

Claims 37-72, previously presented, are pending.

The final Office Action contains a rejection of claims 37-72 under 35 USC 103(a) as being unpatentable over WO 00/50886 (WO '886). Reconsideration is requested.

As implicitly indicated in the previous Office Action (mailed March 3, 2004), filing an English translation of priority application PCT/EP00/01393 would overcome the stated rejection. An English translation of WO '886 (along with English translations of the two German priority documents) were submitted with applicant's response filed September 17, 2004, in the PTO. According to the statement of rejection, the aforesaid English translations are not in the PTO application file (as also indicated, correctly, one of the digits is incorrect in the serial number

appearing on the response filed with the English translations). Accordingly, resubmitted, herewith, are the accurate translations of PCT EP 00/001393, DE 19907296.5, and DE 10004673.8 (the translations need be "accurate" – MPEP 1.55(a)(4)(ii) – not certified).

In this respect, applicant wishes to point out, specifically, to the examiner the text appearing in the specification of the subject continuation-in-part application that is not expressly found in the specification of the PCT (international) priority application, as originally filed. The text at issue is found in the specification of the subject continuation-in-part at page 13, paragraph 2, and at page 18, paragraph 4, second sentence.

As explained in applicant's previously filed response, filing the translation of priority application PCT/EP00/01393 confirms 21 February 2000 as the (domestic) priority date for the subject application. The priority date antedates the effective date of WO '886 as prior art (31 August 2000) and, so, renders the reference unavailable as prior art against the present claims. Since WO '886 is not available as prior art against the present claims, withdrawal of the rejection of claims 37-72 under 35 USC 103(a) based on WO '886 appears to be in order.

With respect to present claims 53-72, withdrawal of the §103(a) rejection over WO '886 removes the only issue of record remaining. Accordingly, present claims 53-72 are in form for immediate allowance.

Claims 32 and 41-43 were rejected under 35 USC 103(b) as allegedly lacking novelty over US 4,544,485 (Pinkerton). Reconsideration is requested.

First of all, the rejection of claim 32 is a moot issue, since the claim was previously cancelled.

Secondly, with respect to claims 41-43 the rejection cannot be maintained, because the claims are dependent on claim 37, which is not rejected over Pinkerton under §102(b). Since claim 37 is not included in the §102(b) rejection based on Pinkerton, novelty of the subject matter of claim 37 over Pinkerton, under §102(b), is admitted in the final Action (at least implicitly). Therefore, claims 41-43 must also be novel over Pinkerton, under §102(b), because they contain the admittedly novel subject matter of claim 37, being dependent thereon. 35 USC 112, ¶4.

Since the Office Action admits (at least implicitly) that claim 37 cannot be rejected under §102(b) over Pinkerton, the Office Action also acknowledges that claims 41-43, which are dependent on claim 37, cannot be rejected under 35 USC 102(b) over Pinkerton, for the foregoing reasons. Accordingly, withdrawal of the rejection of claims 41-43 over Pinkerton under §102(b) appears to be in order.

Claims 33-40, 42, and 44-52 were rejected under 35 USC 103(a) as being allegedly obvious over Pinkerton. Reconsideration is requested.

First of all, as applied against claims 33-36, the §103(a) rejection is a moot issue, since these claims were previously cancelled.

As applied against the remaining claims identified in the rejection, the statement of rejection alleges:

Pinkerton fails to teach the specific chromatographic set-ups claimed.

It would have been obvious to use know[n] formats, such as microchannels, and know[n] chromatographic detectors for their know[n] function of miniaturization and analysis.

The statement of rejection shows that the standards for making a rejection under §103(a) have been neither applied nor satisfied and, therefore, the rejection cannot be maintained.

In the present case, the statement of rejection fails to identify the requisite prior-art motivation necessary to establish obviousness under §103(a). When the claimed invention requires modification of the prior art, there is no obviousness under §103 when "[t]he prior art does not suggest . . . [the] modification . . . or provide any reason or motivation to make the modification." *In re Laskowski*, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989). Instead, the rejection relies merely on the *allegation* that the presently claimed features (limitations) missing from Pinkerton were allegedly *known* in the art.

Therefore, obviousness has not been shown because it is well-established that merely because components of the claimed invention were known, separately, in the prior art. The fact that all elements of a claimed invention are known does not, by itself, make the combination obvious. *Ex parte Clapp*, 227 USPQ 972 (BPA&I 1985). It is legally erroneous to reach a conclusion of obviousness under §103 solely on the basis that the claimed invention represents a "combination which only unites old elements with no change in their functions." *Pentec, Inc. v. Graphic Controls Corp.*, 227 USPQ 766, 771 (Fed. Cir. 1985).

Furthermore, the statement of rejection merely *alleges* that the features (limitations) of the rejected claims were known, which fails to establish obviousness under §103(a). An allegation by the PTO is "not prior art." *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). The PTO cannot "resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis." *In re Warner*, 154 USPQ 173, 178 (CCPA 1967). Since each limitation on the rejected claims is not supported in the relied on prior art (Pinkerton), the rejection is "inadequate on its face." *In re Thrift*, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002).

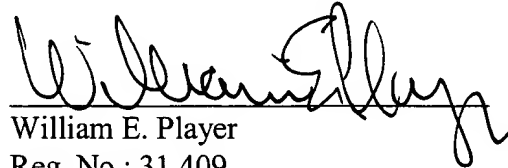
As shown in the foregoing analysis, the rejection under §103(a) based on Pinkerton cannot be maintained. Withdrawal of the rejection appears to be in order.

Favorable action is requested.

Respectfully submitted,

JACOBSON HOLMAN PLLC

By



William E. Player
Reg. No.: 31,409

400 Seventh Street, N.W.
Suite 600
Washington, D.C. 20004
Tel. (202) 638-6666
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